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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/534,646	08/05/2005	Karl M Tischler	P05,0183	7104
26574	7590	11/28/2008	EXAMINER	
SCHIFF HARDIN, LLP			COLILLA, DANIEL JAMES	
PATENT DEPARTMENT				
6600 SEARS TOWER			ART UNIT	PAPER NUMBER
CHICAGO, IL 60606-6473			2854	
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			11/28/2008	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## **DETAILED ACTION**

### ***Specification***

1. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: “**fourth data**” and “**fifth data**” as recited in claims 28-29 and 31 and claims 30, 31 and 33 respectively.

### ***Claim Objections***

2. Claims 29-30, 38 and 41 are objected to because of the following informalities:  
In claim 29, “a first file” and “a file in which the third data are stored” appear to be double recitations of that which has already been recited in claims 23.

In claim 30, line 2 “a further print image” has no proper antecedent basis in the claims. This term implies that a first print image has been recited. However, no such print image has been recited in this line of claims.

In claim 38, applicant recites, “a second data processing system.” This term has no proper antecedent basis because no “first data processing system” has been recited. For the purposes of examination, this will be interpreted simply as --a data processing system.--

In claim 41, line 11, “the second data” has no antecedent basis in the claims.  
Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 23-25, 27-28, 30-32, 36, 38, 39 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sunada *et al.* (2003/0026626) in view of Motamed *et al.* (US 6,549,300) and Tischer (US 2006/0168518).

With respect to claim 23, Sunada *et al.* discloses the claimed method except for generating at least first data that contain at least information for formatting of elements of at least one separate sheet and for storing the first data in a first file and except for storing a third data in an additional file.

Sunada *et al.* discloses a method for printing of a separator sheet 52 with a printer or copier 100, comprising the steps of generating and storing a third data in a file, said third data comprising data of the elements to be printed on the register tab (Sunada *et al.*, paragraph [00622], lines 5-8). Although Sunada *et al.* does not explicitly state that the third data is stored in a file, this feature is inherent since the data has been stored in a memory in advance.

Additionally, Sunada *et al.* discloses printing at least the register tab of the one separator sheet with the print image by the printer or copier 100 (paragraph [0063]).

Furthermore, Sunada *et al.* teaches processing the third data with aid of a second program module (shown in Figs. 6 and 8 of Sunada *et al.* and mentioned in paragraphs [0067] and [0071])

so that second data are generated (tabbed page insertion positions), and via which with aid of said second data print data for generation of a print image on the register tab are added to a print data stream (Sunada *et al.*, paragraph [0007], Fig. 5).

Motamed *et al.* teaches with the aid of a first program module (as shown in Fig. 13 of Motamed *et al.*), generating at least first data (font type and size) that contain at least information for formatting of elements of at least one separator sheet, said elements to be printed on a register tab associated with the at least one separator sheet; storing the first data in a first file (this is inherent since the data must be stored in a memory in a computer to be accessed when printing). Motamed *et al.* further teaches processing the first data and the third data (the tab text added as shown in Fig. 14 of Motamed *et al.*). It would have been obvious to combine the teaching of Motamed *et al.* with the printing method disclosed by Sunada *et al.* for the advantage of being able to format the tab text being printed on the tabbed media.

Tischer teaches storing data to be formatted (digital content) in a first file and formatting data (style definition) in a second file. It would have been obvious to combine the teaching of Tischer for the advantage of being able to store commonly used styles so that they can be quickly applied to data to be formatted.

With respect to claim 24, Motamed *et al.* teaches a first program module (the InsertTabs program, col. 6, lines (42-47) which generate both the third data (Motamed *et al.*, Fig. 14) and the first data (Motamed *et al.*, Fig. 13).

With respect to claim 25, considering different user interface windows as separate program modules, Motamed *et al.* teaches a separate module 500 for generating the third data (Motamed *et al.*, Fig. 14).

With respect to claim 27, Sunada *et al.* teaches image data (data of graphic elements) to as the third data (Sunada *et al.*, paragraph [0062]). Additionally, Fig. 14 of Motamed *et al.* shows that the third data is comprised of text data.

With respect to claim 28, the first data (tab formatting taught by Motamed *et al.*) and the third data (tab label taught by Motamed *et al.* or Sunada *et al.*) are processed for a first print job (document printing) with aid of the second program module (the combining module taught by Sunada *et al.*), the third data being associated with the first print job (since the third data is printed in the first print job, the two are associated). Although not explicitly recited, it would have been obvious to print a second job using, the first data (tab formatting) and fourth data (new tab labels) with the second program module, the fourth data being associated with the second print job (since the fourth data is printed in the second job, the two are associated) since already stored tab label formatting would be a convenient way to format the tabs of a new document.

With respect to claim 30, Sunada *et al.* discloses generation of a print image on a separator sheet outside of the register tab as shown in Figure 9 of Sunada *et al.* The data forming the image in the non-tab region would be the fifth data and the second module would process this data along with the register tab third data.

With respect to claim 31, the second module (shown in Fig. 6 of Sunada *et al.*) indicates that the third data can be selected in step 603. Paragraph [0064] of Sunada *et al.* discloses that the third data can be selected from the image memory 307.

With respect to claim 32, the fifth data is associated with whatever print job is being printed using tabbed separator sheets as shown in Fig. 5 of Sunada *et al.*

With respect to claim 36, the software disclosed by Sunada *et al.* must provide some functions that assist in carrying out the above mentioned processes. These functions would inherently have all the necessary information for the generation of the first data in order for the functions to carry out their intended purpose.

With respect to claim 38, a data processing system is inherently required to carry out the second program module shown in Fig. 6 of Sunada *et al.*

With respect to claim 39, Fig. 8 of Motamed *et al.* teaches wherein the information for formatting contains specification regarding paper format of the separator sheet (tab media size). Additionally, the tab text offset shown in Fig. 11 of Motamed *et al.* would indicate dimensions of the register tab.

With respect to claim 41, Sunada *et al.* discloses the claimed system except for a first data processing system which executes a first program module that generates first data that contain at least information for formatting of elements of at least one separator sheet and for storing the first data in a first file and except for storing a third data in an additional file.

Sunada *et al.* discloses a system for printing of a separator sheet 52 with a printer or copier 100 using third data comprising data of the elements to be printed on the register tab (Sunada *et al.*, paragraph [00622], lines 5-8). Although Sunada *et al.* does not explicitly state that the third data is stored in a file, this feature is inherent since the data has been stored in a memory in advance. Additionally, Sunada *et al.* discloses printing at least the register tab of the one separator sheet with the print image by the printer or copier 100 (paragraph [0063]).

Furthermore, Sunada *et al.* teaches a second data processing system which executes a second program module (shown in Figs. 6 and 8 of Sunada *et al.* and mentioned in paragraphs

[0067] and [0071]) which processes third data so that second data are generated (tabbed page insertion positions), and via which with aid of said second data print data for generation of a print image on the register tab are added to a print data stream (Sunada *et al.*, paragraph [0007], Fig. 5).

Motamed *et al.* teaches with the aid of a first data processing system with a first program module (as shown in Fig. 13 of Motamed *et al.*), generating at least first data (font type and size) that contain at least information for formatting of elements of at least one separator sheet, said elements to be printed on a register tab associated with the at least one separator sheet; storing the first data in a first file (this is inherent since the data must be stored in a memory in a computer to be accessed when printing). Motamed *et al.* further teaches processing the first data and the third data (the tab text added as shown in Fig. 14 of Motamed *et al.*). It would have been obvious to combine the teaching of Motamed *et al.* with the printing method disclosed by Sunada *et al.* for the advantage of being able to format the tab text being printed on the tabbed media.

Tischer teaches storing data to be formatted (digital content) in a first file and formatting data (style definition) in a second file. It would have been obvious to combine the teaching of Tischer for the advantage of being able to store commonly used styles so that they can be quickly applied to data to be formatted.

5. Claims 26 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sunada *et al.* (2003/0026626) in view of Motamed *et al.* (US 6,549,300) and Tischer (US 2006/0168518), as applied to claims 24 and 28 above, respectively, and further in view of (Roztocil *et al.* US 2001/0044868).

With respect to claim 26, Sunada *et al.*, in view of Motamed *et al.* and Tischer discloses the claimed method for printing except for storing the second data and the third data being stored in the additional file. However, Roztocil *et al.* teaches storing third data (tab label) and second data (positional information) in the same document data file (Roztocil *et al.*, paragraph [0068]). It would have been obvious to combine the teaching of Roztocil *et al.* with the method disclosed by Sunada *et al.* in view of Motamed *et al.* and Tischer for the advantage of conveniently locating related data in one single file, thus allowing easier file management.

With respect to claim 29, a file name of the first file in which the first data are stored and a file name of the file in which the third data are stored would inherently be specified as parameters in invocation of the second program module in order for the second program module to identify the first and third data properly and process the first and third data.

6. Claims 33-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sunada *et al.* (2003/0026626) in view of Motamed *et al.* (US 6,549,300) and Tischer (US 2006/0168518), as applied to claim 24 above, and further in view of Barry *et al.* (US 2006/0280538).

With respect to claim 33, Sunada *et al.* in view of Motamed *et al.* and Tischer discloses the claimed method of printing except for the arrangement of elements to be printed on the tabs. However, Barry *et al.* teaches a first data for containing information for arrangement of elements of a separator sheet set to be printed on register tabs as shown in Fig. 17 of Barry *et al.* This figure shows that the rotation and vertical and horizontal alignment of the tab image or text can be specified and stored. In the combination with Sunada *et al.* this data would be added to the print stream by using the second program module for printing a print image on each separate

sheet register tab. It would have been obvious to combine the teaching of Barry *et al.* with the method of printing disclosed by Sunada *et al.* in view of Motamed *et al.* and Tischer for the advantage of additional options in the formatting of the image on the register tab.

With respect to claim 34, Fig. 5 of Sunada *et al.* shows the separator sheets 52 acting as a sorting aid in a loose leaf system of document sheets 51.

7. Claims 35, 37 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sunada *et al.* (2003/0026626) in view of Motamed *et al.* (US 6,549,300) and Tischer (US 2006/0168518), as applied to claim 23 above, and further in view of Hanson *et al.* (EP 1246051).

With respect to claim 35, Sunada *et al.* in view of Motamed *et al.* and Tischer disclose the claimed method of printing except that they are silent on whether the first program module is contained as a program element in a desktop publishing program module. However, Hanson *et al.* teaches that the first program module is contained as a program element in a desktop publishing program module as a plug-in program module (Hanson *et al.*, Fig. 3, paragraph [0061], lines 1-7). It would have been obvious to combine the teaching of Hanson *et al.* with the method disclosed by Sunada *et al.* in view of Motamed *et al.* and Tischer for the advantage of the convenience of desktop publishing software.

With respect to claim 37, see Fig. 7 and paragraphs [0064, 0068] of Hansen *et al.* that teach a view of the separator sheet with register tab of a separator sheet set with the register tabs is simulated and displayed with aid of the first program module.

With respect to claim 40, see paragraphs [0061-0068] of Hansen *et al.* that teach a preview of a separator sheet with selected settings is possible in the first program module [0061-

0064], whereby data with the settings as parameters are transferred to the second program module, the second program module transfers the generated second data to the first program module (software in the computer system includes plurality of program modules that allow setting/generating data for the separator sheet), and with the first program module the second data are further processed into display data with aid of a program element.

***Response to Arguments***

8. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection. Specifically, the newly cited references Sunada *et al.* teaches processing first and third data to create second data so that a print image on a register tab is added to a print stream.

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Daniel J. Colilla** whose telephone number is **571-272-2157**. The examiner can normally be reached on M-F 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Judy Nguyen** can be reached at **571-272-2258**. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

November 29, 2008

/Daniel J. Colilla/  
Primary Examiner  
Art Unit 2854



## EXAMINER'S CASE ACTION WORKSHEET

<b>Copy (Ctrl+C)</b>	Palm Transaction Code 1340 73019285410534646		Legal Instrument Examiner
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CHECK TYPE OF ACTION

DATE OF COUNT

<input type="checkbox"/> Non-Final Rejection	<input type="checkbox"/> Restriction/Election Only	<input checked="" type="checkbox"/> Final Rejection
<input type="checkbox"/> Ex Parte Quayle	<input type="checkbox"/> Allowance	<input type="checkbox"/> Advisory Action
<input type="checkbox"/> Examiner's Answer	<input type="checkbox"/> Reply Brief Noted	<input type="checkbox"/> Non-Entry of Reply Brief
<input type="checkbox"/> Defective Notice of Appeal	<input type="checkbox"/> Interference Disposal SPE _____ (Approval for Disposal)	<input type="checkbox"/> Suspension (Examiner-Initiated) SPE _____ (initial)
<input type="checkbox"/> Defective Appeal Brief	<input type="checkbox"/> SIR Disposal (use only after FAOM)	<input type="checkbox"/> Supplemental Examiner's Amendment
<input type="checkbox"/> Miscellaneous Office Letter (With Shortened Statutory Period Set)	<input type="checkbox"/> Notice of Non-Responsive Amendment (With One Month Time Period set)	<input type="checkbox"/> Miscellaneous Office Letter (No Response Period Set)
<input type="checkbox"/> Abandonment after BPAI Decision	<input type="checkbox"/> Supplemental Action	<input type="checkbox"/> Response to Rule 312 Amendment
<input type="checkbox"/> Letter Restarting Period for Response (e.g., Missing References)	<input type="checkbox"/> Interview Summary	<input type="checkbox"/> Authorization to Change Previous Office Action SPE: _____ (Initial)
<input type="checkbox"/> Abandonment	<input type="checkbox"/> Express Abandonment Date: _____	<input type="checkbox"/> Other

Examiner's Name: Daniel J. Colilla

AU: 2854

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/534,646	TISCHLER, KARL M	
	<b>Examiner</b>	<b>Art Unit</b>	
	Daniel J. Colilla	2854	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 20 August 2008.

2a) This action is **FINAL**.                            2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 23-41 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 23-41 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.

5) Notice of Informal Patent Application

6) Other: \_\_\_\_\_.